

REMARKS

The Office has set forth a requirement that applicants elect a single invention to which the claims will be restricted:

Group I - claims 14-31 - drawn to a joint compound composition; or

Group II - claims 32-44 - drawn to a method of producing a structure.

Applicants elect, with ***traverse***, for further examination Group I- claims 14-31 - drawn to a joint compound composition.

As the Office has recognized, this application is subject to the Unity of Invention standard for PCT application. The Office has not properly applied this standard.

As stated in MPEP §1893.03(d) "Examiners are reminded that unity of invention (***not restriction practice pursuant to 37 CFR 1.141 - 1.146***) is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371."

Further, MPEP §1893.03(d) explains that "The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. ***See MPEP § 1850 for a detailed discussion of Unity of Invention.*** The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept."

The Office attempted an analysis according to the "single general inventive concept that involves a common special technical feature." However, it is in MPEP § 1850, that the impropriety of the present restriction becomes clear. MPEP § 1850 recites that "Although lack of unity of invention should certainly be raised in clear cases, ***it should neither be raised nor maintained on the basis of a narrow, literal or academic approach.*** There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each

claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, ***the benefit of any doubt being given to the applicant.***"

Here, the Office has alleged that "Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. The Examiner notes these references where from applicants' submitted PCT International Search Report and all categorized as Y references. Nevertheless, the examiner could have provided other references as well to sufficiently teach claim 14 yet these would seem sufficient." Here, the Office has not set up a full and proper explanation of lack of inventive step - the required standard in this unity of invention analysis. The Office asserts that it ***could have*** provided other references. Without these other references, there is inherently some ***doubt***. Further, a full analysis under *KSR* showing the specific finding that the combination was predictable and the reasoning for making the combination are not disclosed by the Office. Clearly, this shows that there is at least some ***doubt*** regarding whether there is inventive step. Respectfully, ***the benefit of any doubt must be given to the applicant.*** This is the specific requirement of MPEP § 1850, governing the Unity of Invention analysis.

Accordingly, the lack of Unity of Invention must be withdrawn and all pending claims examined.

Applicants believe that the foregoing is fully responsive to the outstanding Official Action including the restriction and the election of species requirement. If, however, the Examiner believes that any further information or election is required, the Examiner is encouraged to contact applicants' attorney at the number provided below. Such informal communication will expedite examination and disposition of the case.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:

A handwritten signature in black ink, appearing to read "T.D. Boone", written over a horizontal line.

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